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Supreme Court of the United States

OCTOBER TERM 1943

No. 810

PHILIP EGNER, FREDERICK C. MAYER and SHAPIRO, BERNSTEIN & CO., INC.,

Petitioners,

against

E. C. SCHIRMER MUSIC COMPANY.

PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT, AND BRIEF IN SUPPORT THEREOF

JOSEPH FISCHER,
Counsel for Petitioners.

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PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners respectfully pray for a writ of certiorari to review the decree of the United States Circuit Court of Appeals for the First Circuit entered December 29, 1943, in the above entitled cause and as cause therefor respectfully show:

Statement

The action was brought under the Copyright Act (U. S. C. Tit. 17) to enjoin the alleged infringement of copyright of a musical composition variously known as "The Caisson Song", "The Artillery Song" and "The Caissons Go Rolling Along". The complaint alleges in substance (R. 2-5) that the song was composed by Edmund

L. Gruber; that prior to June 8, 1921, he assigned the composition, together with all rights therein, including the right to secure copyright therefor, to plaintiffs Egner and Mayer; that, on June 8, 1921, Egner and Mayer published the song in a book or collection of "Songs of the United States Military Academy, West Point, N. Y." and thereafter secured copyright of the book; that on January 23, 1936, Egner and Mayer assigned to Gruber all rights in the song, reserving a license to continue to publish and sell the book with the song incorporated therein; that on February 6, 1936, Gruber assigned to plaintiff Shapiro, Bernstein & Co., Inc., all rights in the song, with authority to institute and prosecute actions for infringement, and Egner and Mayer, by agreement of the same date, confirmed the assignment by Gruber to Shapiro, Bernstein & Co., Inc., with the reservation to Egner and Mayer of the license aforesaid; that plaintiff Shapiro, Bernstein & Co., Inc., has since been the sole proprietor of the exclusive right to print, publish and sell the song subject to the aforesaid license, and that defendant, after February 6, 1936, infringed the copyright by publishing a song entitled "Caisson Song", which was copied from plaintiffs' copyrighted song.

The answer (R. 7-8) denied authorship, copyright and infringement and avers that any rights plaintiffs ever had were lost by acquiescence, *laches* and delay in bringing suit.

Publication by defendant was conceded (R. 12) as also that if plaintiff has a valid copyright there is infringement (R. 23, cf. 48).

Plaintiffs' evidence showed, and the District Court found, that the song was an original musical composition written in 1908 by Edmund L. Gruber, who was an officer in an artillery regiment of the United States Army (R. 16, 142, 157-158, 172-3).

In 1921 plaintffs Egner and Mayer, the former being bandmaster and the latter organist and choirmaster in the United States Military Academy, were requested by Colonel

Danford, Commandant of Cadets at West Point, to compile a book of West Point songs (R. 23-5). He suggested including the Caisson song (R. 26, 162).

Having decided upon the songs to be included in the compilation (R. 29), Egner and Mayer then addressed themselves to the copyright question (R. 31). With particular reference to the Caisson song Mayer testified he had written Gruber and also conversed with him (R. 33, 36). (The correspondence was destroyed within a few months after the publication of the book [R. 35] and Gruber died shortly after this action was brought [R. 141, 164].) Mayer testified he wrote Gruber: "We wanted very much to have that song for our book and would he give us the rights for that purpose" (R. 33), and that Gruber's response, given either in a letter or orally, was: "'I give you the song and the right to copyright the song. It is understood that if in the future' . . . well, the only string that he interposed was that if in the future the song should possess potential value as a separate composition . . . it was understood that Lieut. Egner and I would do the fair and right thing by him" (R. 39). The District Court found (R. 17) that Mayer could not remember whether the so-called assignment was made prior to the date of his copyright; but Mayer testified (R. 40) that they went ahead with the arrangements for the printing and publication of the book "after we had definitely reached a basis for every single song in the book concerning the copyright protection or permissions". Publication was made June 8, 1921 (Plffs.' Ex. 2, offered R. 22, printed R. 193); and Mayer's final testimony on this subject is (R. 42) that he had Gruber's "complete word" before June 8, 1921.

Elliott Shapiro testified (R. 57-58) that when in the last week of December, 1935, or the first week in January, 1936, he entered negotiations with Gruber relative to the acquisition of the song by his firm (Shapiro, Bernstein & Co., Inc.), Gruber said, "Mr. Shapiro, I would like to give you those rights, but I have already parted with them . . . I

parted with the rights to Messrs. Egner and Mayer". After he took an assignment from Egner and Mayer (Plffs.' Ex. 8, offered R. 44, printed R. 201), Gruber delivered an assignment to Shapiro, Bernstein & Co. (Plffs.' Ex. 12, offered R. 59, printed R. 209), and a royalty contract (Plffs.' Ex. 13, offered R. 60-61, printed R. 211), accompanied by a letter and an affidavit (Plffs.' Exs. 14, 15, offered R. 64, printed R. 213), in which he stated that he had not authorized or consented to the publication of the song other than in the Egner and Mayer song book; in the letter (Ex. 14) he refers to their copyright, and, at his instance, as Shapiro testified (R. 65-6) his royalty contract (Plffs.' Ex. 13) was revised by eliminating the printed reference to an unpublished composition and substituting the words "original musical composition heretofore copyrighted by Egner and Mayer by arrangement with the writer".

After 1908 the song was played or sung at military functions and came into popularity during the first World War (R. 162). Then followed various other publications of the song. In January, 1918, Carl Fischer Inc. published "U. S. Field Artillery March, by John Philip Sousa" (R. 9, Deft.'s Ex. 19, offered R. 127, printed R. 253-6), in which Sousa incorporated most, if not all, of the Caisson song (R. 17). The song was also included in "Songs the Soldiers and Sailors Sing", published by Leo Feist, Inc. (R. 9-10, Deft.'s Ex. 21, offered R. 127, not printed, cf. R. 263-4). The words of the song, but not the music, were included in the "Army Song Book of U. S.", issued by the War Department 1918, for free distribution to all officers and men in the Army, and intended for use solely by song leaders in the Army (R. 10, 127, 168-9, Deft.'s Ex. 20, offered R. 127, not printed, cf. R. 263-4). It was published in the "Home and Community Song Book" by the Boston Music Company in 1919 (R. 10, Deft.'s Ex. 13, offered R. 88, not printed, cf. R. 263). The defendant's publication was a continuation of the same book (R. 7, 128, Deft.'s Ex. 18, offered R. 126-7, not printed, cf. R. 263). In 1920 C. C. Birchard published "The Boy

Scout Song Book", in which this song was included (R. 10, Deft.'s Ex. 17, offered R. 117, not printed, cf. R. 263).

There is no evidence of consent by Gruber to any of these publications.

It was included in several other publications after Egner and Mayer secured copyright registration in 1921.

Egner and Mayer's West Point Song book was published June 8, 1921, with proper copyright notice (R. 42-43, Plffs.' Ex. 1, offered R. 21, not printed, cf. R. 262), was issued to incoming cadets about July 1, 1921, and placed on sale at the cadet store and at the West Point Hotel (R. 43), and copyright registration therefor was secured (Plffs.' Ex. 2, offered R. 22, printed R. 193; Plffs.' Ex. 3, offered R. 22, printed R. 195-6).

Determination of District and Circuit Courts

The District Court found (R. 16) that Gruber was the composer and creator of this song; that (R. 17) Gruber did not assign all of his right, title and interest in the song in 1921 to the plaintiffs Egner and Mayer, but, at most, gave them permission to include the song in their West Point compilation; that (R. 17-18, 19) there was such a general publication of his work as to amount to a dedication of it to the public use; that (R. 20-21) the plaintiffs are barred by *laches;* and rendered judgment (R. 14-15) dismissing the complaint.

The Circuit Court of Appeals accepted the finding of the Trial Court that Gruber did not assign to Egner and Mayer in 1921 (R. 268); that the latter were licensees and held that as such licensees and not assigns they were not proprietors and therefore could not copyright the song when they copyrighted their compilation (R. 270), and that when their compilation was put on sale, this publication with the consent of Gruber amounted to such a general publication as to dedicate the song to the public and worked an abandonment of Gruber's common law right to a copyright, and affirmed the judgment (R. 269).

Jurisdiction

(a) The jurisdiction of this Court is invoked under

Copyright Act, Sec. 38, Act of March 4, 1909, C. 320, 35 Stat. 1084 (17 U. S. C. Sec. 38).

Judicial Code, Sec. 240 (a), as amended by Act of February 13, 1925 C 229, Sec. 1, 43 Stat. 938 (28 U. S. C. Sec. 347).

(b) The date of the decree sought to be reviewed is December 29, 1943 (R. 269).

Statutes Involved

The pertinent provisions of the Copyright Act (March 4, 1909 C. 320, 35 Stat. 1075 et seq., 17 U. S. C.) are as follows:

Section 3. "The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted . . . The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title."

Section 8. "The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the terms specified in this title . . ."

Section 25. "If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable: (a) to an injunction restraining such infringement; . . ."

Section 55. "In the case of each entry the person recorded as the claimant of the copyright shall be entitled to

a certificate of registration under seal of the copyright office . . . Said certificate shall be admitted in any court as prima facie evidence of the facts stated therein."

Questions Presented

The questions presented are as follows:

1. Whether the courts below were at liberty to disregard the evidence that Gruber in 1921 assigned to Egner and Mayer all his right, title and interest in the song.

Subordinate questions:

2. Whether upon the evidence there has been an abandonment of the song.

3. Whether upon the evidence the plaintiffs are barred by *laches*.

Reasons for Granting Writ

1. (a) The Circuit Court of Appeals has in this case decided an important question of federal law which has not been, but should be, settled by this Court. That question, the chief question here presented, relates to the quantum of proof requisite to establish an assignment as a basis for a valid copyright. The Circuit Court of Appeals appears to have rested its decision (R. 268) upon the findings of the Trial Court (R. 17), "that Gruber did not assign all of his right, title and interest in the song in 1921 to the plaintiffs Egner and Mayer, but at most, gave them permission to include the song in their West Point compilation" and upon that basis held the copyright invalid.

(b) The decision of the Circuit Court of Appeals sustaining the finding of the trial judge (R. 269) is also probably in conflict with the decision of this Court in *Chesapeake &*

O. R. Co. v. *Martin*, 283 U. S. 209, 216-7, 51 S. Ct. 453, holding that while the question of the credibility of witnesses is one for the jury alone, "this does not mean that the jury is at liberty, under the guise of passing upon the credibility of a witness to disregard his testimony, when from no reasonable point of view is it open to doubt" and the fact that the witness in that case was an employee of the petitioner was not enough, in the circumstances in that case to take the question to the jury. We submit that ruling is applicable here, although the trier of the facts was the Court and not a jury.

2. If petitioner's contention on this proposition is sustained then there arise the subordinate questions hereinbefore propounded.

(a) The ruling of the District Court (R. 17-18) that the singing of the song in army cantonments in 1917 and 1918, the Sousa publication and other publications constituted such a general publication as to imply an abandonment of the right of copyright. This ruling we submit is probably in conflict with the decisions of this Court in *Ferris* v. *Frohman*, 223 U. S. 424, 435, 32 S. Ct. 263, and *American Tobacco Co.* v. *Werckmeister*, 207 U. S. 284, 299-300, 28 S. Ct. 72. In the former case it was held that the public representation of a dramatic composition, not printed or published, does not deprive the owner of his common-law right save by operation of statute; and that at common law the public performance of a play is not an abandonment of it to public use. In the *Werckmeister* case this Court held in effect that a limited publication is not a dedication to the public.

(b) The ruling of the District Court (R. 20-21) that plaintiffs are barred by *laches* is probably in conflict with the decision of the Court in *Menendez* v. *Holt*, 128 U. S. 514, 524, 9 S. Ct. 143 (a trade mark case) to the effect that *laches* may defeat the remedy so far as the act complained of is

completed, "but so far as the act is in progress and lies in the future, the right to the intervention of equity is not generally lost by previous delay".

For these reasons it is respectfully submitted that this petition should be granted.

Dated: New York, March 21, 1944.

JOSEPH FISCHER,
Counsel for Petitioners.